

Remarks:

Claims 1–16 are pending with claims 1, 8, and 14 being independent. In the Office Action, claims 1, 3, 4–6 and 8–12 were rejected under 35 U.S.C. § 102(b) as being anticipated by Morimoto et al., U.S. Patent No. 5,757,359. Claims 14–16 were allowed, and claims 2, 7, and 13 were deemed to contain allowable subject matter but were objected to as being dependent upon a rejected base claim. The Office Action followed a telephone interview between the Examiner and the attorney for Applicant in which the “Examiner proposed that claims 2 and 13 be canceled and their respective subject matter be incorporated into their respective base claims 1 and 8. The proposed amendment was not deemed acceptable to the attorney.” (Office Action, page 2, ¶ 1.)

Regarding the rejection of claims 1 and 8, Applicant respectfully maintains that the Examiner has failed to establish a proper basis for rejection under 35 U.S.C. § 102(b) as Morimoto fails to disclose all claimed features of the present invention. Morimoto fails to disclose, for example, a navigation device with a “portable handheld housing.”

In the Office Action the Examiner asserted that the meaning of “portable” is not limited to “capable of being carried” but further means “easily . . . moved”; and that “FIG. 16 at least meets that definition.” (Page 2, ¶ 3.) It should be noted that the housing recited in claims 1 and 8 is not only *portable*, but is also *handheld*. Therefore, regardless of the meaning assigned the term “portable,” claim 1 is drawn to a device that is “handheld,” or “[c]ompact enough to be *used or operated while being held in the hand or hands*.” (THE AMERICAN HERITAGE DICTIONARY OF THE ENGLISH LANGUAGE (4th Ed. 2000)) Examples of handheld devices given in the application include a personal digital assistant (PDA) and a wireless communications device. (Application page 17, lines 16–19.)

Applicant respectfully asserts that the invention disclosed in Morimoto is neither portable nor handheld. It is not portable in that (using the Examiner’s definition of “portable”) it is not “easily moved.” The system of Morimoto, for example, is not only intended to be mounted in a vehicle, but is *integral with* the vehicle. For example, the invention includes a display that is “a *color CRT* or a color liquid crystal display and is *mounted in the instrument panel* near the driver’s

seat.” (Col. 8, lines 31–33; col. 10, lines 64–65; emphasis added.) Note that the invention contemplates a cathode ray tube display, which requires substantial space and power to operate. Furthermore, the display is mounted *in* (not “on”) the instrument panel. Thus, the system includes a display that is integral with the instrument panel, similar to, for example, a speedometer, tachometer, odometer, etc.

The system of Morimoto is further integral with the system in that it connects to, and receives information from, an array of sensors embedded in various vehicle components. For example, the device receives information relating to vehicle speed from a wheel speed sensor and an acceleration meter (col. 5, lines 4–7; col. 6, lines 25–27; FIG. 16); and information relating to a relative direction from a wheel sensor or a steering sensor, and information relating to a distanced traveled from a distance sensor that senses “the number of revolutions of the wheels” (col. 11, lines 18–22; FIG. 16).

Thus, the system of Morimoto is integral with a vehicle and therefore is not “easily moved.” To move the device, for example, one would need to remove the display from *within* the instrument panel, and find and remove the computing and control circuitry that drive the display. The various sensors listed above would need to be found and removed. (Merely disconnecting the various sensors would also be tedious, and would render the system unsatisfactory for its intended purpose, as explained below.) Furthermore, the vehicular power source would need to be disconnected from the display, the computing and control circuitry, and various peripheral components. If the device were to be moved to a second vehicle for use therein, the lengthy and tedious process of removing the system from the first vehicle would have to be reversed to install the system in the second vehicle. Therefore, moving the system of Morimoto is a long and tedious process that is anything but easy, rendering the system non-portable.

Furthermore, the system of Morimoto is not handheld. As explained above, a device is handheld if it “can be used or operated while being held in the hand or hands.” The system of Morimoto is integral with a vehicle and therefore is not adapted to be used while being held in the hand or hands, as explained previously. The Morimoto system is operable to adapt to different driving conditions, for example, and therefore relies on the various vehicle sensors to acquire information relating to the driving conditions. These sensors, of course, would not be available if

the system were removed from the vehicle for use as a handheld device. The system of Morimoto further includes components that are not compatible with a handheld device, such as, for example, a printer (col. 10, lines 38–48; number 415 of FIG. 16) and the CRT display (col. 8, lines 31–33; col. 10, lines 54–55). These components are not only too large and heavy for use in a handheld device, but impose power demands beyond that which a handheld or portable device can reasonably be expected to meet.

The Examiner asserts that the overall construction of FIG. 16 disclose a portable handheld housing. (Office Action, page 2, ¶ 3.) Applicant respectfully disagrees. Morimoto does not mention a system housing of any sort, much less a portable handheld housing. Furthermore, a portable handheld housing would be utterly incompatible with the system disclosed in FIG. 6. The system, for example, includes a printer (numeral 415 of FIG. 16; col. 10, lines 38–39, 47); components for detecting information indicating the present position of the vehicle (numerals 424–27 of FIG. 16; col 10, lines 16–19); and a display (including a CRT) that is mounted *in the instrument panel* of the vehicle, not in a portable, handheld housing (numeral 414 of FIG. 16; col. 10 lines 54–55, 64–65). Therefore, Morimoto does not disclose a portable handheld housing, but rather discloses a system that is utterly incompatible with a portable handheld housing.

Finally, there is no suggestion or motivation to modify Morimoto to house the system in a portable handheld housing because such a modification would render the invention unsatisfactory for its intended purpose, and further because Morimoto suggests modifying the system to include additional components that are not used with portable handheld devices. First, modifying the system to be housed in a portable handheld housing would render it unsatisfactory for its intended purpose. The system is intended to be used with a vehicle and to automatically adapt its functionality according to a status of the vehicle such as, for example, running/stopped (col. 4, line 63 – col. 5, line 2) and vehicle speed (col. 5, lines 3–6). As explained above, the system receives this information via various vehicle sensors (numerals 424–27). Placing the system of Morimoto in a portable, handheld housing would disconnect the vehicle sensors from the system and thus render it unable to determine a status of the vehicle and adapt its functionality accordingly. Placing the system of Morimoto in a portable handheld housing would also render it impossible to include the

printer (discussed above). Furthermore, Morimoto suggests modifying the system to include additional components that are not used with portable handheld devices. Morimoto suggests, for example, using a "joy stick, mouse, or wireless controller to select the input keys" (col. 7, lines 65-68). Therefore, Morimoto lacks any suggestion or motivation to modify the system to reside within a portable handheld housing and, in fact, teaches away from such a modification.

Therefore, the Examiner has failed to establish a proper basis for rejection under 35 U.S.C. § 102(b) as Morimoto fails to disclose all claimed features of the present invention, including a navigation device with a "portable handheld housing," as set forth in independent claims 1 and 8. Claims 2-7 depend from claim 1, and claims 9-13 depend from claim 8.

In view of the remarks herein, applicant respectfully submits that claims 1-13 are now in allowable condition and requests a Notice of Allowance. In the event of further questions, the Examiner is urged to call the undersigned. Any additional fee which is due in connection with this amendment should be applied against our Deposit Account No. 19-0522.

Respectfully submitted,

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